

REMARKS

This responds to the Final Office Action mailed March 7, 2006 in the above-identified application. Based on the following comments, reconsideration and allowance of the application are respectfully requested.

Claims 1-14 and 16-30 are currently pending in the application. No claims have been amended. Accordingly, claims 1-14 and 16-30 are pending for examination, with claims 1, 8, 16, 22, 27 and 28 being independent claims.

Withdrawal of Final Status

As a preliminary manner, Applicant notes that the final status of the Office Action mailed March 7, 2006 is improper. MPEP § 706.07(a) states that:

...second or subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)... (emphasis added)

Applicant notes that the Office Action mailed March 7, 2006 contains a new ground of rejection based on previously un-cited prior art that was neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement. The Examiner states on page 9 of the Office Action that "Applicant's amendment necessitated the new grounds of rejection presented in this Office action," however Applicant's previous communication with the Examiner was a Request for Reconsideration which contained no claim amendments.

Applicant spoke with the Examiner on this matter on August 7, 2006. The Examiner indicated that the Applicant's previous remarks included a definition of "instruction" which noted that the customary meaning of "instruction" to one of ordinary skill in the art is a "construct that specifies or causes an operation to be performed and identifies its operands." (Request for Reconsideration dated February 17, 2006). Applicant supported this definition with remarks and cites to the *IBM Dictionary of Computing* (1987) and the *Illustrated Dictionary of Electronics* (1991). Examiner noted that this definition altered the Examiner's understanding of

“instruction” and therefore led the Examiner to make the present Office Action final. The Examiner noted, however, that if the Applicant could point to a case which noted that Applicant’s definition was the customary definition of “instruction” to one of ordinary skill in the art, Examiner would reconsider the final status of the Office Action.

Applicant refers the Examiner to Cornell University v. Hewlett-Packard Co., 313 F. Supp. 2d 114 (N.D.N.Y. 2004). There, the court had reason to consider the meaning of the word “instruction” in the context of claim construction. The court stated:

The contemporaneous ordinary and customary meaning of the term “instruction” is fully consistent with the patent...the Court construes the term “instruction”...to mean “an expression that specifies one or more operations and identifies the applicable operands.”

Id. at 131, 145. This definition, which the court notes is the ordinary and customary meaning, comports with Applicant’s proposed definition of “instruction.” Given the action by the court in Cornell, as well as the remarks and citations provided by Applicant in its previous responses, Applicant believes it has sufficiently shown that its definition of “instruction” is the customary meaning as understood by one of ordinary skill in the art and that no change in definition has occurred. Accordingly, Applicant respectfully requests the Final status of the Office Action be withdrawn.

Rejections Under 35 U.S.C. §103

Claims 1-14 and 16-30 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Agrawal (U.S. Patent No. 6,879,576) and Catherwood (U.S. Patent No. 6,934,728). Applicant respectfully disagrees and traverses as follows.

The Catherwood Reference Is Not Prior Art to the Application

Catherwood is cited in support of the rejection under § 103(a). Although Examiner does not specifically cite which section of 35 U.S.C. § 102 qualifies Catherwood as prior art to the Application, Applicant assumes Examiner cited Catherwood under § 102(e) as none of the other sections are applicable.

As indicated in the Declaration of Jose Fridman Under 37 C.F.R. § 1.131, submitted herewith, the present invention was reduced-to-practice prior to June 1, 2001, the filing date of

Catherwood.

As indicated in the Declaration and Exhibit A thereto, the invention of the claims of the application was reduced-to-practice prior to June 1, 2001. (Fridman Dec. ¶ 2). Exhibit A, which shows an invention disclosure and supporting application describes the complex multiply and accumulate engine, the accelerated despread instruction, and the form of the instruction, including operands. The Exhibit further discusses the implementation of the register structure and despread instructions in the TigerSHARC Digital Signal Processor, which implemented the above.

As stated in the declaration, the register design, single cycle operation, and despread instruction and operation were reduced-to-practice prior to June 1, 2001. (Fridman Dec. ¶¶ 3, 4). Because the present invention was invented prior to Catherwood, Catherwood is not prior art to the Application under § 102(e) and may not be considered under § 103(a) to support an obviousness rejection.

The § 103 Rejection

As Catherwood is not prior art to the Application, the rejection under § 103 cannot stand. As the Examiner notes, "Agrawal does not disclose the complex multiplication, complex addition and storing of the despread result are executed in a single clock cycle of the DSP." (Office Action at 3).

Claim 1 is therefore patentable over Agrawal for at least this reason.

The remaining independent claims, 8, 16, 22, 27 and 28, also contain similar limitations regarding the execution of operations in response to a single instruction and within a single clock cycle. Those claims are therefore patentable for at least the same reasons described above in reference to claim 1. The dependent claims are therefore patentable for at least the same reasons.

Accordingly, withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
Rifaat, et al., Applicant

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